

REMARKS

Formal Matters

Claims 29-30, 36-40, 46-49, 52-54 are currently pending in this application. Claims 1-28, 31-35, 41-45 and 50-51 were previously canceled.

Applicants note, with appreciation, that the Examiner has withdrawn the rejection of claims 29, 30, 36-40, 46-49, and 52-54 under 35 U.S.C. § 112, second paragraph.

35 U.S.C. § 103(a)

The Office Action maintains the rejection of claims 29, 30, 36-40, 46-49 and 52-54 under 35 U.S.C. § 103(a) as allegedly being obvious over Motoyama *et al.*, (1998) *Nat. Genet.* 18(2): 104-106 in view of U.S. Patent No. 5,932,448 to Tso *et al.* (“Tso”).

The Examiner concedes that Motoyama does not teach or suggest antibodies that bind to human patched-2 or even mouse patched-2. Furthermore, the Examiner concedes that Motoyama does not teach a patched-2 protein with the claimed sequence identity to SEQ ID NO:2; the protein disclosed by Motoyama is described by the Examiner as “89.3% similar” to SEQ ID NO: 2 (Office Action dated Oct. 30, 2007, p. 6, lines 11-13). The Office Action argues that it would be obvious to use the method described by Tso to produce antibodies against mouse patched-2, and that such antibodies would fall within the scope of the claimed invention.

Applicants earnestly submit that the Examiner fails to establish a sufficient motivation for one of ordinary skill in the art to make antibodies against the mouse patched-2 protein. The argument essentially is since antibodies can be made from proteins, the disclosure of any protein under the sun would render obvious the making of an antibody without any motivation other than antibodies “have general uses applicable for use with any protein...” (Office Action dated July 15, 2008, p. 4, lines 6-7). This, despite the fact that neither reference teaches or suggests a specific motivation to create an antibody against the *patched-2 protein*. There is no teaching that such an antibody would have any specific or substantial utility to one of skill in the art except

that it *might be possible* to create such an antibody to mouse patched-2. One must extrapolate further that *if* such an antibody were created, it would *also* necessarily have affinity for the human homologue (which is also not described in either reference!). In short, the Office Action bases the rejection on an assumption that one of ordinary skill in the art would be motivated to produce an antibody against the specific protein (mouse patched-2). That motivation is an assumption that is not established by the cited references. The Applicants submit that the lack of specific motivation is an insufficient basis for an obviousness rejection.

In view of the discussion above, Applicants request that the Examiner reconsider the rejection under 35 U.S.C. § 103 over Motoyama in view of Tso. As stated in Applicants previous response, Motoyama does not teach a polypeptide with the requisite degree of identity to SEQ ID NO:2, and the references (alone or in combination) fail to teach or even suggest antibodies that specifically bind to a polypeptide having the amino acid sequence of SEQ ID NO:2, or even that an attempt should be made to make such antibodies against this specific protein.

Applicants earnestly submit that claims 29, 30, 36-40, 46-49 and 52-54 distinguish over Motoyama in view of Tso, and respectfully request withdrawal of the rejection under 35 U.S.C. § 103(a).

SUMMARY

Claims 29, 30, 36-40, 46, 49 and 52-54 are pending in the application. Applicants respectfully request reconsideration and allowance of the claims as amended.

If in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject application, the Examiner is strongly encouraged to call the undersigned at the number indicated below.

This response is submitted with a Petition for a one-month extension of time and requisite fee. However, in the unlikely event that this document is separated from the transmittal letter or if fees are required, applicants petition the Commissioner to authorize charging our Deposit Account 07-0630 for any fees required or credits due and any extensions of time necessary to maintain the pendency of this application.

Applicants respectfully request allowance of the claims as presented herein.

Respectfully submitted,
GENENTECH, INC.

Date: November 17, 2008

By: /Patrick J. Farley/
Patrick J. Farley, Ph.D.
Reg. No. 42,524
Telephone No. (650) 467-3618